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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,711	02/07/2001	Tomoji Asada	450100-02994	4182
20999	7590	10/14/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/778,711	Applicant(s) ASADA ET AL.	
	Examiner Thai Tran	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed July 25, 2005 have been fully considered but they are not persuasive.

In re pages 9-11, applicants argue that Itoh and Liebenow, individually or in combination, do not teach or suggest a receiving device in which control of an external recording device is disabled if the received program is found copy protected before recording that program onto an external recording device; whereby the external recording device is prevented from recording received copy protected programs as recited in independent claims 1, 7, and 13.

In response, the examiner respectfully disagrees. Ito discloses in col. 31, lines 41-61 that "The moving-image readout/reception device 80 is usually furnished with the reproducing display device 81 or/and the video recording (storing) device 82 ... **the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted (to be recorded or/and displayed), so as to permit or bar the image output...** the output control can be performed immediately". From the above passage, it is clear that the copy control information contained in the read-out/received data is used to bar the image output which anticipates the claimed "a receiving device in which control of an external recording device is disabled if the received program is found copy protected before recording that program onto an external recording device; whereby the external recording device is

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prevented from recording received copy protected programs". Thus, Itoh does indeed disclose the alleged claimed limitation of independent claims 1, 7, and 13.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al (US 6,700,989 B1) in view of Liebenow (US 6,601,074 B1) as set forth in the last Office Action.

Regarding claim 1, Itoh et al discloses a receiving system (Fig. 27) composed of a receiving device, a monitor device for displaying an output of said receiving device, and an external recording device to be controlled by said receiving device, said receiving device comprising:

external device control means (a readout/reception device 80 of Fig. 27, col. 31, lines 29-61) for setting an operation of said external recording device; and

control means (a readout/reception device 80 of Fig. 27, col. 31, line 29 to col. 32, line 59 and col. 34, lines 55-65) for, when a recording input is given, determining whether or not a program being received is copy protected, setting said external recording device to a recording state if said program is initially found not copy protected, and disabling control said external recording device if said program is found copy protected before recording said received program onto said external recording device; whereby said external recording device is prevented from recording received copy protected programs. However, Itoh et al does not specifically disclose on-screen display control means for displaying a screen corresponding to various setting states and arranging items on said screen.

Liebenow teaches that the program can be requested for recording using the electronic program guide (EPG) (Fig. 2, col. 3, lines 18-39 and from col. 4, line 66 to col. 5, line 57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of requesting a program to be recorded by using electronic program guide as taught by Liebenow into Itoh et al's system in order to simplify the process of requesting program to be recorded.

Regarding claim 2, the proposed combination of Itoh et al and Liebenow discloses all the claimed limitations as discussed above with respect to claim 1 except for providing the claimed wherein, if said program is found copy protected when

said recording input is given, a warning indicative of copy protection is displayed on said screen.

The capability of displaying a warning indicative of copy protection on an on-screen display device is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known displaying a warning indicative of copy protection on an on-screen display device into Itoh et al's system in order to notify the user that the program can not be recorded so that the user can determine whether to record the program again.

Regarding claim 3, Itoh et al also discloses the claimed wherein, when said recording input is given, an on-screen display is provided for stopping recording (col. 31, lines 29-40 and col. 34, lines 55-65).

Regarding claim 4, Itoh et al discloses the claimed wherein, when said recording input is given, a button for stopping recording is put in a selected state on said screen (col. 31, lines 29-40 and col. 34, lines 55-65).

Regarding claim 5, Liebenow teaches the claimed wherein said external device control means controls said external recording device by using an AV mouse (the mouse disclosed in col. 3, lines 2-17).

Regarding claim 6, the proposed combination of Itoh et al and Liebenow discloses all the claimed limitations as discussed above with respect to claim 1 except for providing the claimed wherein said external device control means controls said

external recording device by using an IEEE 1394 interface.

Itoh et al also disclosed in col. 2, lines 45-55 the well known IEEE1394 interface.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IEEE 1394 into the combination of Itoh et al and Liebenow in order to increase the transmitting speed of the data because IEEE 1394 has high transfer speed.

Claims 7-12 are rejected for the same reasons as discussed in claims 1-6 above.

Method claims 13-18 are rejected for the same reasons as discussed in apparatus claims 1-6 above.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

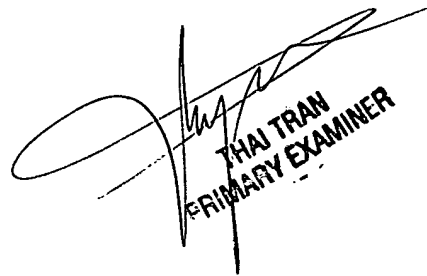
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN  
PRIMARY EXAMINER